UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/759,966	01/16/2004	Jordi Albornoz	POU920030137US1	8190

23334　　7590　　04/25/2007	EXAMINER
FLEIT, KAIN, GIBBONS, GUTMAN, BONGINI & BIANCO P.L. ONE BOCA COMMERCE CENTER 551 NORTHWEST 77TH STREET, SUITE 111 BOCA RATON, FL 33487	MADAMBA, CLIFFORD B

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SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/25/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

PTOL-90A (Rev. 10/06)

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 January 2004*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

Status of Claims

1. This action is in reply to Application 10/759,966 filed on January 16, 2004.

2. Claims 1-20 are currently pending and have been examined.

Information Disclosure Statement

3. The Information Disclosure Statement filed on January 16, 2004 has been considered. An initialed copy of the Form 1449 is enclosed herewith.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

   Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 10-16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

6. **As per claims 10-16,** a computer program product, per se, is not statutory, lacking storage on a medium which enables any underlying functionality to occur.

Claim Rejections – 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this office action:

> A person shall be entitled to a patent unless –
>
> (b) The invention was patented or described in a printed publication in this or a foreign country or in public use or sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Ensel et al., U.S.

Patent 6,493,685 (Ensel).

9. **As per claim 1**, Ensel teaches the following:

- *A method for providing automatic recurring online payments, the method comprising the step of: receiving, from a user, an automatic recurring online payment configuration;* disclosing an enrollment database containing all of the information relevant to the customer wherein the enrollment data can either be manually entered and updated in the enrollment database and/or files can be received (see at least column 10, lines 21-49 and column 12, lines 43-47); and

- *The method comprising the step of: sending a notification to the user of a pending automatic payment based on the automatic recurring online payment configuration;* disclosing an embodiment capable of delivering secure email notices of bill availability (see at least column 14, lines 30-34); and

- *The method comprising the step of: determining whether or not to execute the pending automatic payment based on at least one of a response to the notification received from the user and a lack of a response to the notification from the user*, disclosing accomplishment by the payment processor of payment processing by executing customer payment instructions (see at least column 14, lines 57-59); wherein responses can include any type of response or instruction from a customer (see at least column 7, lines 61-64). Ensel further discloses an embodiment capable of processing negative responses or any type of response or instruction from a customer (see at least column 12, lines 59-60 and column 7, lines 61-64) or initiating the automatic payments prescribed in the enrollment profiles including pre-authorizations without any initiative required by the customers (see at least column 14, lines 54-56; column 10, lines 43-45).

10. **As per claim 2,** Ensel teaches the method of claim 1 as described above. Ensel further teaches the method, *wherein the automatic recurring online payment configuration includes a source account for the automatic recurring online payment, a recipient of the automatic recurring online payment, and at least one payment date*; disclosing where payment would be debited from the customer's account and would be credited to the biller's account (see at least column 11, lines 54-60) with specific reference to a payment preference date (see at least column 10, lines 43-45).

11. **As per claim 3,** Ensel teaches the method of claim 1 as described above. Ensel further teaches the method, *wherein the notification comprises at least one of an email message*

and an instant message; disclosing an embodiment capable of delivering secure email notices of bill availability (see at least column 14, lines 30-34).

12. **As per claim 4**, Ensel teaches the method of claim 1 as described above. Ensel further teaches the method, *wherein the determining step comprises the sub-step of: receiving the response to the notification from the user; and if the response from the user authorizes the pending automatic payment, executing the pending automatic payment according to the automatic recurring online payment configuration*; disclosing where the email message sent to the customer contains code which enables the customer to formulate its payment instructions which are then sent back in a return email message (see at least column 8, lines 60-66); and, wherein responses can include any type of response or instruction from a customer (see at least column 7, lines 61-64) and also wherein in processing payments, the enrollment file is accessed in order to retrieve the customer's payment instructions (see at least column 11, lines 66-67 and column 12, lines 1-2).

13. **As per claim 5**, Ensel teaches the method of claim 4 as described above. Ensel further teaches the method, *wherein the determining step further comprises the sub-step of: if the response from the user modifies the pending automatic payment, executing the pending automatic payment as modified*; disclosing where the email message sent to the customer contains code which enables the customer to formulate its payment instructions which are then sent back in a return email message (see at least column 8, lines 60-66); and, wherein responses can include any type of response or instruction from a customer (see at least column 7, lines 61-64).

14. **As per claim 6**, Ensel teaches the method of claim 4 as described above. Ensel further teaches the method, *wherein the determining step further comprises the sub-step of: if the response from the user suspends the pending automatic payment, suspending the pending automatic payment*; disclosing where the email message sent to the customer contains code which enables the customer to formulate its payment instructions which are then sent back in a return email message (see at least column 8, lines 60-66); and, wherein responses can include any type of response or instruction from a customer (see at least column 7, lines 61-64).

15. **As per claim 7**, Ensel teaches the method of claim 4 as described above. Ensel further teaches the method, *wherein the determining step further comprises the sub-step of: if the response from the user cancels the pending automatic payment, canceling the automatic recurring online payment*; disclosing where the email message sent to the customer contains code which enables the customer to formulate its payment instructions which are then sent back in a return email message (see at least column 8, lines 60-66); and, wherein responses can include any type of response or instruction from a customer (see at least column 7, lines 61-64).

16. **As per claim 8**, Ensel teaches the method of claim 1 as described above. Ensel further teaches the method, *wherein in the determining step, if a response to the notification is not received from the user, it is determined to execute the pending automatic payment*; disclosing where with respect to payments, an embodiment is capable of processing negative responses or any type of response or instruction from a customer (see at least column 12, lines 59-60 and column 7, lines 61-64) or initiating the automatic payments

prescribed in the enrollment profiles including pre-authorizations without any initiative required by the customers (see at least column 14, lines 54-56; column 10, lines 43-45).

17. **As per claim 9**, Ensel teaches the method of claim 1 as described above. Ensel further teaches the method, *wherein in the determining step, if a response to the notification is not received from the user, it is determined to suspend the pending automatic payment or cancel the automatic recurring online payment*; disclosing where with respect to payments, an embodiment is capable of processing negative responses or any type of response or instruction from a customer (see at least column 12, lines 59-60 and column 7, lines 61-64) or initiating the automatic payments prescribed in the enrollment profiles including pre-authorizations without any initiative required by the customers (see at least column 14, lines 54-56; column 10, lines 43-45).

18. **As per claim 10**, Ensel teaches the following:

- *A computer program product for providing an automatic online payment, the computer program product comprising a storage medium readable by a processing circuit and storing instructions for execution by the processing circuit*; disclosing the use of an information interface between a biller and its customers capable of processing payments (see at least column 3, lines 46-48, and at least column 3, lines 57-59); and

- *The computer program product for performing a method comprising the step of: receiving, from a user, an automatic recurring online payment configuration*; disclosing an enrollment database containing all of the information relevant to the customer

wherein the enrollment data can either be manually entered and updated in the
enrollment database and where files can be received (see at least column 10, lines 21-
49 and column 12, lines 43-47); and

- *The computer program product for performing a method comprising the step of: sending
  a notification to the user of a pending automatic payment based on the automatic
  recurring online payment configuration;* disclosing an embodiment capable of delivering
  secure email notices of bill availability (see at least column 14, lines 30-34); and

- *The computer program product for performing a method comprising the step of:
  determining whether or not to execute the pending automatic payment based on at least
  one of a response to the notification received from the user and a lack of a response to
  the notification from the user;* disclosing accomplishment by the payment processor of
  payment processing by executing customer payment instructions (see at least column
  14, lines 57-59); wherein responses can include any type of response or instruction from
  a customer (see at least column 7, lines 61-64). Ensel further discloses an embodiment
  capable of processing negative responses or any type of response or instruction from a
  customer (see at least column 12, lines 59-60 and column 7, lines 61-64) or initiating the
  automatic payments prescribed in the enrollment profiles including pre-authorizations
  without any initiative required by the customers (see at least column 14, lines 54-56;
  column 10, lines 43-45).

19. **As per claim 11**, Ensel teaches the computer program product of claim 10 as described
above. Ensel further teaches the computer program product, *wherein the notification*

comprises at least one of an email message and an instant message; disclosing an embodiment capable of delivering secure email notices of bill availability (see at least column 14, lines 30-34).

20. **As per claim 12,** Ensel teaches the computer program product of claim 10 as described above. Ensel further teaches the computer program product, *wherein the determining step comprises the sub-step of: receiving the response to the notification from the user; and if the response from the user authorizes the pending automatic payment, executing the pending automatic payment according to the automatic recurring online payment configuration;* disclosing where the email message sent to the customer contains code which enables the customer to formulate its payment instructions which are then sent back in a return email message (see at least column 8, lines 60-66); and, wherein responses can include any type of response or instruction from a customer (see at least column 7, lines 61-64); and also wherein in processing payments, the enrollment file is accessed in order to retrieve the customer's payment instructions (see at least column 11, lines 66-67 and column 12, lines 1-2).

21. **As per claim 13,** Ensel teaches the computer program product of claim 12 as described above. Ensel further teaches the computer program product, *wherein the determining step further comprises the sub-step of: if the response from the user modifies the pending automatic payment, executing the pending automatic payment as modified;* disclosing where the email message sent to the customer contains code which enables the customer to formulate its payment instructions which are then sent back in a return email message (see

at least column 8, lines 60-66); and, wherein responses can include any type of response or instruction from a customer (see at least column 7, lines 61-64).

22. **As per claim 14**, Ensel teaches the computer program product of claim 12 as described above. Ensel further teaches the computer program product, *wherein the determining step further comprises the sub-steps of: if the response from the user suspends the pending automatic payment, suspending the pending automatic payment; and, if the response from the user cancels the pending automatic payment, canceling the automatic recurring online payment;* disclosing where the email message sent to the customer contains code which enables the customer to formulate its payment instructions which are then sent back in a return email message (see at least column 8, lines 60-66); and, wherein responses can include any type of response or instruction from a customer (see at least column 7, lines 61-64); and also wherein in processing payments, the enrollment file is accessed in order to retrieve the customer's payment instructions see at least column 11, lines 66-67 and column 12, lines 1-2):

23. **As per claim 15**, Ensel teaches the computer program product of claim 10 as described above. Ensel further teaches the computer program product, *wherein in the determining step, if a response to the notification is not received from the user, it is determined to execute the pending automatic payment;* disclosing where with respect to payments, an embodiment is capable of processing negative responses or any type of response or instruction from a customer (see at least column 12, lines 59-60 and column 7, lines 61-64) or initiating the automatic payments prescribed in the enrollment profiles including pre-

authorizations without any initiative required by the customers (see at least column 14, lines 54-56; column 10, lines 43-45).

24. **As per claim 16**, Ensel teaches the computer program product of claim 10 as described above. Ensel further teaches the computer program product, *wherein in the determining step, if a response to the notification is not received from the user, it is determined to suspend the pending automatic payment or cancel the automatic recurring online payment;* disclosing where with respect to payments, an embodiment is capable of processing negative responses or any type of response or instruction from a customer (see at least column 12, lines 59-60 and column 7, lines 61-64) or initiating the automatic payments prescribed in the enrollment profiles including pre-authorizations without any initiative required by the customers (see at least column 14, lines 54-56; column 10, lines 43-45). ·

25. **As per claim 17**, Ensel teaches the following:

- *A computer system for providing automatic recurring online payments, the computer system comprising: a receiver receiving, from a user, an automatic recurring online payment configuration;* disclosing an enrollment database containing all of the information relevant to the customer wherein the enrollment data can either be manually entered and updated in the enrollment database and where files can be received (see at least column 10, lines 21-49 and column 12, lines 43-47); and

- *A computer system for providing automatic recurring online payments comprising: a transmitter sending a notification to the user of a pending automatic payment based on*

the automatic recurring online payment configuration; disclosing specific types of channels of distribution utilized by the embodiment including email (see at least column 8, lines 14-15); and

- *A computer system for providing automatic recurring online payments comprising: a processor determining whether or not to execute the pending automatic payment based on at least one of a response to the notification received from the user and a lack of a response to the notification from the user,* disclosing accomplishment by the payment processor of payment processing by executing customer payment instructions (see at least column 14, lines 57-59); and, wherein responses can include any type of response or instruction from a customer (see at least column 7, lines 61-64).

26. **As per claim 18,** Ensel teaches the computer system of claim 17 as described above. Ensel further teaches the computer system, wherein *the response to the notification is received from the user, and if the response from the user authorizes the pending automatic payment, the processor executes the pending automatic payment according to the automatic recurring online payment configuration;* disclosing where the email message sent to the customer contains code which enables the customer to formulate its payment instructions which are then sent back in a return email message (see at least column 8, lines 60-66); and, wherein responses can include any type of response or instruction from a customer (see at least column 7, lines 61-64); and also wherein in processing payments, the enrollment file is accessed in order to retrieve the customer's payment instructions (see at least column 11, lines 66-67 and column 12, lines 1-2).

27. **As per claim 19**, Ensel teaches the computer system of claim 18 as described above. Ensel further teaches the computer system, *wherein if the response from the user modifies the pending automatic payment, the processor executes the pending automatic payment as modified*; disclosing where the email message sent to the customer contains code which enables the customer to formulate its payment instructions which are then sent back in a return email message (see at least column 8, lines 60-66); and, wherein responses can include any type of response or instruction from a customer (see at least column 7, lines 61-64); and also wherein in processing payments, the enrollment file is accessed in order to retrieve the customer's payment instructions (see at least column 11, lines 66-67 and column 12, lines 1-2).

28. **As per claim 20**, Ensel teaches the computer system of claim 19 as described above. Ensel further teaches the computer system, *wherein if the response from the user suspends the pending automatic payment, the processor suspends the pending automatic payment, and if the response from the user cancels the pending automatic payment, the processor cancels the automatic recurring online payment*; disclosing where the email message sent to the customer contains code which enables the customer to formulate its payment instructions which are then sent back in a return email message (see at least column 8, lines 60-66); and, wherein responses can include any type of response or instruction from a customer (see at least column 7, lines 61-64); and also wherein in processing payments, the enrollment file is accessed in order to retrieve the customer's payment instructions (see at least column 11, lines 66-67 and column 12, lines 1-2).

Conclusion

29. The prior art made of record and not relied upon is considered pertinent to the applicant's

disclosure.

- Schutzer, US Patent 6,292,789 teaches a method and system of bill presentment and
  payment.

- Remington et al., US Patent 6,070,150 teaches an electronic bill presentment and
  payment system.

- Kolling et al., US Patent 6,385,595 teaches an electronic statement presentment system.

- Kolling et al., US Patent 5,920,847 teaches an electronic bill pay system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clifford Madamba whose telephone number is 571-270-1239. The examiner can normally be reached on Mon-Thu 7:30-5:00 EST Alternate Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James A. Reagan can be reached on 571-270-1245. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Clifford Madamba
Patent Examiner
March 16, 2007

JAMES A. REAGAN
PRIMARY EXAMINER